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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,190	06/02/2005	Paolo Corvi Mora	27419-230	1281

7590 08/04/2009
NIXON PEABODY LLP
Clinton Square
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Rochester, NY 14603

EXAMINER

KOSAR, AARON J

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,190	Applicant(s) CORVI MORA ET AL.	
	Examiner AARON J. KOSAR	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-10, 15-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2009 has been entered.

Applicant's amendment and arguments filed February 4, 2009 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed is herein withdrawn.

Claims 1-11, 15-18, 20, and 21 are pending and have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1-10, 15-18, 20, and 21 remain rejected under 35 U.S.C. 103(a) as being obvious over Aga (1999, U.S. Patent No. 5,922,324) in view of Mandai (1999, U.S. Patent No. 6,005,100 A) and Zaffaroni (1975, U.S. Patent No. 3,876,816 A) and Kasori (1985, JP 60188036 A, as evidenced by Derwent Abstract) for the reasons of record.

Response to Arguments

Applicants' arguments as they pertain to the USC 103 rejection above have been carefully considered but are not deemed to be persuasive of error in the rejection.

Applicant has argued that the motivation to combine/substitute glycyrrhizate and trehalose is based on a different intended use (flavor) than instantly claimed (solubility) and that solubility of Aga is adjusted for different reasons (by adjusting pH) versus the instant claims (trehalose addition). Applicant has also argued that each of the references do not teach glycyrrhizate as a co-grinding substance or a glycyrrhizate-amino acid increased solubility synergy. Applicant has further argued that certain components are distinguished from the prior art in being co-ground.

In response to applicant's argument that the prior art provides a different intended use (imparting flavor and/or pH-adjusting versus solubility), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure (composition) is capable of performing the intended use (e.g. having solubility), then it meets the claim. Please note, in the instant case, for the reasons of record, one would arrive at the components from the combined teachings of Mandai, Zaffaroni, and Kasori for the reasons of record.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention (unexpected solubility; ground components), it is noted that the features upon which applicant relies (i.e., glycyrrhizate-amino acid synergy; ground (versus "grinding") substances) are not recited in the rejected claim(s). Also, in the instant case only: **(a)**

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claim 1 taken with the combination of claims 2 and 3, or **(b)** claim 11, recite a fully disclosed composition having the alleged unexpected solubility properties as argued by Applicant.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Since the results are alleged to be unexpected/synergistic, the providing a very water-soluble compound (e.g. glycyrrhizate, trehalose) to a composition having a degree of water-solubility, to the contrary, would be expected to positively affect/increase water-solubility of the bulk composition. Also, as argued *supra*, said property of solubility is an aqueous property and thus compositions having similar chemical combinations and physical (powdered) form, would be expected to intrinsically have the claimed properties, especially in the absence of evidence to the contrary, side by side comparison(s), or evidence to the criticality of some undisclosed features.

Allowable Subject Matter

Claim 11 is allowable.

To hasten prosecution, it is strongly suggested that claim 1 be amended so as to appropriately incorporate the limitations of claims 2 and 3 therein. Claim 1, amended as such, would be allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON J. KOSAR whose telephone number is (571)270-3054. The examiner can normally be reached on Monday-Thursday, 7:30AM-5:00PM, ALT. Friday,EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron J Kosar/
Examiner, Art Unit 1651

/Christopher R. Tate/
Primary Examiner, Art Unit 1655